Claims 1 and 8 stand rejected under 35 U.S.C 102(e) as being anticipated by Tanaka et al. (US PAT: 6,243,442 B 1, filed 12- 19- 1997, hereinafter Tanaka). This rejection is respectfully traversed.

Regarding claim 1, according to the Examiner, "Tanaka discloses a method for processing an emergency call made from behind a PBX/MLTS, the method comprising the steps of: within the PBX/MLTS determining whether the dialed digits represent an emergency number (fig. 4, col. 10, lines 14-30), assigning priority (fig. 6, col. 10, lines 8-13) within the PBX/MLTS to call determined to be an emergency call (col. 10, lines 63-67, col. 11, lines 1-67, col. 12, lines 1-35)."

It is respectfully submitted that the cited portions of Tanaka do not teach or suggest claim 1 as filed. Moreover, it is respectfully submitted that the amendment to claim 1 makes it abundantly clear that it is neither anticipated nor suggested by Tanaka.

Figure 4 is not discussed in columns 10-12 of Tanaka. Nevertheless, column 10 discusses the routing of an emergency call to a preselected trunk line.

> "Flags are disposed corresponding to the line number (No.) in the selected line number memory section 32, as shown in FIG. 5, and composed to enable the retrieval of the line to be captured in case of emergency call. Here, the line of the line number "3" is supposed to be the line corresponding to the emergency call. As shown in FIG. 6, the dial memory section for special line 29 stores previously the data of the dial number to be transmitted in case of emergency call, in response to the line number (No.). Here, it is shown that the data of the dial number "911" should be transmitted to the line of the line number "3"." Col. 10, lines 2-13 (emphasis added).

Column 11 of Tanaka reiterates the capture of a preselected trunk line when 911 is dialed.

> "If the dial data delivered from the dial data detection section 24 agrees with the given emergency dial number "911", the connection line control section 31 accesses the selection line number memory section 32 to read out the line number (No) to be captured by the line interface (S205). Here, as the line number "3" is stored in the selection line number memory section 32, the line number "3" will be obtained. Moreover, the connection line control section 31 creates the release data of the line actually captured by the digital key telephone 2 and the data of the

line number "3" of the line to be connected and sends these data to the speech highway control section 27 (S206)." Col. 11, lines 14-24.

Column 12 of Tanaka explains that, regardless of the line selected by the user, the system routes 911 calls to a preselected trunk line and that other calls may not capture the trunk line reserved for 911 calls.

> "According to the present embodiment, when the user wants to originate the emergency call, he/she is only required to capture the line by the off-hook by unhooking the hand set 22 of an extension terminal or the operation of the extension key, the station line key or the leased line key and to key input the dial data for emergency call for releasing once the actually captured line and then capturing the line for emergency call to originate the emergency call. As a consequence, when the user wants to originate the emergency call, the user has only to key-input the dial data for emergency call without paying attention to the kind of line to be captured. Consequently, even when the user is flustered, he/she can originate the emergency call rapid and securely, and this advantage is quite remarkable. Note that, a plurality of lines may be provided for the emergency call, though it was supposed to be one line in this example. Moreover, the control section 11-2 controls the capture inhibition so that the line for emergency call may not be captured by an ordinary call." Col. 12, lines 16-34 (emphasis added).

From the foregoing it is clear that Tanaka teaches a system by which one or more trunk lines are reserved for 911 calls, other calls are not permitted to use the reserved trunk line(s) and 911 calls are automatically routed to the reserved trunk line(s). This is quite different from what is claimed in original claim 1 and more specifically in amended claim 1.

The present invention relates to the priority routing of emergency calls made behind a PBX/MLTS before reaching a public network trunk line. See Figure 1 of the instant application and note the connections between 10 and 16. It is here that the present invention prioritizes emergency calls. Tanaka teaches a completely different system regarding the assignment of trunk lines. The assignment of trunk lines has nothing to do with the present invention. Tanaka does not teach or suggest the prioritizing of calls within a private network. In fact, Tanaka specifically teaches away from this in Col. 12 where it is stated that:

"According to the present embodiment, when the user wants to originate the emergency call, he/she is only required to capture the line by the off-hook by unhooking the hand set 22 of an extension terminal or the operation of the extension key, the station line key or the leased line key and to key input the dial data for emergency call for releasing once the actually captured line and then capturing the line for emergency call to originate the emergency call." Col. 12, lines 16-23 (emphasis added).

Tanaka thus states that even if a leased line is selected, the apparatus will release that line and select the predetermined emergency trunk line when the user dials 911. The present invention concerns the internal routing of emergency calls over a private network, something not contemplated by Tanaka.

Regarding claim 8, according to the Examiner, "Tanaka further discloses an apparatus (fig. 4) for processing an emergency call made from behind PBX/MLTS for determining whether dialed digits represent an emergency number (fig. 4, col. 10, lines 14-30), means for assigning priority (fig. 6, col., 10 lines 8-13) within the PBX/MLTS to a call determined to be an emergency call (fig. 7, col. 10, lines 48-67, col. 11, lines 1-67, col. 12, lines 1-35)." This is substantially the same rejection as the rejection of claim 1 but for the inclusion of Figure 7 of Tanaka which is fully discussed at cols. 10-12 of Tanaka. Thus, the cited teachings of Tanaka utilized in this rejection are the same as those discussed above.

Claim 8 is an apparatus claim which closely corresponds to the method claim 1. Claim 8 has also been amended in a manner similar to the amendment made to claim 1. Thus, the arguments made above regarding claim 1 apply equally to claim 8.

Claims 2-7 and 9-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Hoskinson et al. (US PAT: 5,339,351, hereinafter Hoskinson). This rejection is respectfully traversed.

Regarding claims 2-3, 9-10, according to the Examiner, "Tanaka teaches the following: storing a port number for each device/trunk in the PBX/MLTS and determining from which port the emergency call originated (col. 9, lines 63-67, col. 10, lines 1-30); but he does not teach the following: associating an emergency location identification number (ELIN) with each port

equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated."

According to the Examiner, "Hoskinson discloses a emergency response system which teaches the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point (reads on emergency response center 23 in fig. 1) the ELIN associated with the port from which the emergency call originated (col. 7, lines 18-20, fig. 3, col. 7, lines 56-68, col. 8, lines 1-4)."

According to the Examiner, "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Tanaka's system to provide for the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art."

Insofar as claims 2 and 3 depend from claim 1, the remarks made above regarding claim 1 apply to this rejection as well. Similarly, insofar as claims 9 and 10 depend from claim 8, the remarks made above regarding claim 8 apply to this rejection as well.

Claims 2 and 9 relate to the association of a port equipment number with an ELIN and claims 3 and 10 relate to transmitting the appropriate ELIN to the PSAP.

The Examiner admits that Tanaka does not teach or suggest the features of claims 2, 3, 9, and 10. He suggests that these features are taught by Hoskinson and that it would have been obvious to combine the teachings of Hoskinson with those of Tanaka. It is not clear from the Examiner's rejection what the incentive would have been to make this combination. The rejection states that "this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art." However, the Examiner does not cite a single reference to establish that this indeed is "well known in the art".

Before discussing the teachings of Hoskinson and the likelihood of making a combination with Tanaka, it must be respectfully pointed out that the Examiner's unsupported assertion that the incentive to combine these references is "well known in the art" does not satisfy the requirements for a complete rejection.

MPEP 706.02(j) "Contents of a 35 U.S.C. 103 Rejection" provides as follows:

> "35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:
>
> (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
>
> (B) the difference or differences in the **claim** over the applied reference(s),
>
> (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
>
> (D) an **explanation** why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.
>
> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest **all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly

suggest **the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd.Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant.

Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. See MPEP § 2141 - § 2144.09 generally for guidance on patentability determinations under 35 U.S.C. 103, including a discussion of the requirements of Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). See MPEP § 2145 for consideration of applicant's rebuttal arguments. See MPEP § 706.02(l) -§ 706.02(l)(3) for a discussion of prior art disqualified under 35 U.S.C. 103(c)." [Emphasis added.]

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 202 U.S.P.Q. 500 (C.C.P.A. 1979). See, also, ACS Hospital Sys., Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929 (Fed. Cir. 1984). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so."

Without providing evidence of incentive to combine, the combination of references is based on hindsight. To draw on hindsight knowledge of the applicant's Specification, when the prior art does not contain or suggest the knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process in which to determine patentability. In In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999), the Federal Circuit noted that

> "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id. at 1617

The simplicity of the invention does not remove the Examiner's duty of providing evidence of a teaching or motivation. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Id.

Hoskinson discloses a location identification module which transmits location information to an emergency response center in response to a request from an emergency operator. This is quite different from what is claimed in claims 2, 3, 9, and 10. According to these claims, an emergency location identification number is associated with each port equipment number for each device in the PBX/MLTS. Hoskinson does not teach or suggest the use of port equipment numbers or location identification numbers. Hoskinson specifically refers to a separate location identification module for each telephone, preferably one per residence. Hoskinson is not particularly concerned with PBX systems. His preferred embodiment is a residential phone. Nevertheless, when discussing PBX systems, Hoskinson states:

> "In accordance with this invention, an emergency response system that includes a location identification module associated with each residence or extension of a PBX or the like, is provided." Col. 2, lines 35-38.

"As a matter of fact, while the preferred form of the invention in a residence environment is a solid state hardware module, in the case of a PBX, the invention could be incorporated in the software operating the PBX." Col. 3, lines 63-67.

"As noted above, associated with each residence and the PBX (or each telephone of the PBX if the PBX covers a large area) is a location identification module that stores information about the location of an associated telephone or telephones, i.e., the address of the residence, the address of the PBX or the location of a PBX telephone, which may be an apartment number, an office number, etc." Col. 5, lines 30-37.

Thus, Hoskinson teaches that the location identification module is preferably hardware but possibly software and that the location information is an apartment number or an office number. This is a very vague teaching and does not even come close to suggesting the association of port equipment numbers with emergency location identification numbers set out in the rejected claims. While Hoskinson is admittedly related art, it requires a large amount of hindsight to leap from Hoskinson's meager disclosure to the specific details of claims 2, 3, 9, and 10.

Regarding claims 4-7 and 11-14, the Examiner states that "Tanaka teaches the following: storing a port number for each device/trunk in the PBX/MLTS and determining from which port the emergency call originated (col. 9, lines 63-67, col. 10, lines 1-30); but he does not teach the following: associating a callback number with each port equipment number, transmitting to a public safety answering point the callback number associated with the port from which the emergency call originated, associating an emergency location identification number (ELIN) and callback number with each port equipment number, transmitting to a public safety answering point the ELIN and callback number associated with the port from which the emergency call originated."

According to the Examiner, "Hoskinson teaches the following: associating a callback number with each port equipment number, transmitting to a public safety answering point the callback number associated with the port from which the emergency call originated (col. 3, lines 1-9, col. 9, lines 15-24), associating an emergency location identification number (ELIN) and callback number with each port equipment number, transmitting to a public safety answering point the ELIN and callback number associated with the port from which the emergency call

originated (col. 7, lines 18-20, fig. 3, col. 7, lines 56-68, col. 8, lines 1-4, col. 3, lines 1-9, col. 9, lines 15-24)."

The Examiner concludes "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Tanaka's system to provide for the following: associating a callback number with each port equipment number, transmitting to a public safety answering point the callback number associated with the port from which the emergency call originated as this would facilitate the emergency call center operator to callback the telephone number of caller who inadvertently or in the heat of the situation hangs up the calling telephone in order to obtain the location identification information and also in order to dispatch help for emergency caller as taught by Hoskinson, associating an emergency location identification number (ELIN) and callback number with each port equipment number, transmitting to a public safety answering point the ELIN and callback number associated with the port from which the emergency call originated as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art."

The rejected claims concern associating a callback number with each port equipment number and transmitting the callback number as well as the emergency location identification number to the PSAP. Contrary to the Examiner's assertion, it is respectfully submitted that the cited portion of Tanaka has nothing to do with port equipment numbers. It only relates to the selection of a predetermined trunk for making a 911 call. Figure 3 of Hoskinson relates to the emergency response center. Thus, it teaches nothing about the claimed invention which is not located at the emergency response center. The cited portions of Hoskinson also do not relate to port equipment numbers, or callback number. The only cited portion of Hoskinson which appears to be even marginally relevant is at Col. 3, lines 1-9 where it is stated that:

> "In accordance with further aspects of this invention, preferably the emergency code detector remains enabled for a predetermined period of time after an emergency code is dialed even if the calling telephone goes on-hook. This allows an emergency dispatcher to call back and, when the calling telephone goes off-hook, obtain telephone location information, which is not available to the normal caller due to the ring signal disabling the emergency code detector."

While this text seems to suggest something about calling back, it fails to teach or even suggest applicants' claimed invention. Specifically, the cited text (nor indeed the entire reference) never explains how the emergency code detector allows an emergency dispatcher to call back. There is certainly no teaching of transmitting telephone number information to the emergency center. The only number transmitted by Hoskinson is the address of the calling location. It is respectfully submitted that, a careful reading of Hoskinson will reveal that Hoskinson teaches away from transmitting the caller's telephone number.

In conclusion, therefore, it is respectfully submitted that the Examiner has not made out a prima facie case for obviousness and that the claims are thus allowable over the art of record.

New claims 15 and 16 have been added. These claims require that the emergency call be given priority without interrupting an existing call. To the extent that Tanaka teaches prioritizing an emergency call, Tanaka teaches away from new claims 15 and 16. Tanaka teaches that an existing call be interrupted to make a trunk available for an emergency call.

In view of the foregoing, it is respectfully requested that all of the foregoing amendments and newly added claims be entered. It is further requested that the rejections of record be withdrawn.

It is respectfully submitted that all claims of record are in condition for allowance. Reconsideration and allowance of this application at an early date is respectfully requested.

Respectfully submitted,

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VERSION OF CLAIMS WITH MARKINGS SHOWING CHANGES MADE

1. (amended) A method for processing an emergency call made from behind a PBX/MLTS coupled to a private network, said method comprising the steps of:

a) within the PBX/MLTS determining whether dialed digits represent an emergency number; and

b) assigning priority within the PBX/MLTS to a call determined to be an emergency call, such that said call takes priority over other calls in traversing said private network before reaching a public network trunk.

8. (amended) An apparatus for processing an emergency call made from behind a PBX/MLTS coupled to a private network, said apparatus comprising:

a) means within the PBX/MLTS for determining whether dialed digits represent an emergency number; and

b) means for assigning priority within the PBX/MLTS to a call determined to be an emergency call, such that said call takes priority over other calls in traversing said private network before reaching a public network trunk.

VERSION OF SPECIFICATION PARAGRAPH WITH MARKINGS SHOWING CHANGES MADE

This application is related to co-owned co-pending application Serial Number 09/816,843 entitled "Methods And Apparatus For Transmitting Accurate Emergency Location Identification Numbers (ELINs) From Behind A Multiline Telephone System (MLTS) Utilizing Port Equipment Numbers"; co-owned co-pending application Serial Number 09/816,830 entitled "Methods And Apparatus For Transmitting Over A Private Network Accurate Emergency Location Identification Numbers (ELINs) From Behind A Multiline Telephone System (MLTS) Utilizing Port Equipment Numbers"; co-owned co-pending application Serial Number 09/816,823 entitled "Methods And Apparatus For Transmitting Accurate Emergency Location Identification Numbers (ELINs) From Behind A Multi-Line Telephone System (MLTS) After An Emergency Caller Disconnects"; co-owned co-pending application Serial Number 09/816,838 entitled "Methods And Apparatus For Transmitting Accurate Emergency Location Identification Numbers (ELINs) After An Emergency Caller Disconnects"; co-owned co-pending application Serial Number 09/815,685 entitled "Methods and Apparatus For Dialing An Emergency Telephone Number From A Teleworking Client Remotely Coupled to a PBX"; and co-owned co-pending application Serial Number 09/815,468 entitled "System For Dialing An Emergency Telephone Number From A Teleworking Client Remotely Coupled To A PBX", the complete disclosures of which are hereby incorporated by reference.